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10/524,267	02/06/2006	Wilhelm Muller		4096

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EXAMINER

LAM, DUNG LE

ART UNIT	PAPER NUMBER
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2617

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/524,267	Applicant(s) MULLER, WILHELM	
	Examiner DUNG LAM	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

The specification is missing the above underlined headings.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-11 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites,

“A method for handling a location data request or location request relating to a subscriber in a mobile radio network, comprising:

a. receiving a request from a first location request handling device at a subscriber database of a mobile radio network, for switching device address data of a switching device, via which the subscriber can currently be reached; and

b. determining whether the request is from a version of a location request handling device for which there is provision for the location request handling device to receive switching device address data from the subscriber database as a response,

c. wherein in the event that the request is from such a version of a location request handling device, specifying, via the subscriber database, to the first location request handling device, in a response, location request handling device address data representing the address of a further location request handling device instead of the switching device address data.”

Limitation 1b is calling for the step of determining whether location request handling device is of a version which has been provisioned/pre-arranged to receive switching device address data. However, limitation 1c implies that if the request is indeed from such version that is prearranged to receive the switching address, then just simply receive a further handling device and don't receive the switching device address data. This sound contradictory because it's

the same as stating if a network component satisfied the “if” condition to receive x data, then don’t receive x data, instead just receive y data. Thus, the “if” condition and the “then” statement seems disconnected and have no logical connection.

Claim 11 recites

“A device for handling a location data request or location request relating to a subscriber in a mobile radio network, comprising:

a subscriber database of the mobile radio network receiving a request from a first location request handling device at a subscriber database of the mobile radio network, for switching device address data of a switching device, via which the subscriber can be reached, wherein

the database determines whether the request is from a version of a location request handling device for which there is provision for the location request handling device to receive switching device address data from the subscriber database as a response, and

in the event that the request is from such a version of a location request handling device, to specify, via the subscriber database, to the first location request handling device, in a response, location request handling device address data representing the address of a further location request handling device instead of the switching device address data. “

Regarding claim 11, the examiner notes that a database is a collection of data which can only be viewed and stored data on. Actions can be performed on a database. However, a database can not perform action.

The examiner also notes that a device/apparatus claim should contain structures rather than functional descriptive language/data.

For examination purpose, the examiner will provide the broadest reasonable interpretation of the claims in light of the specification³.

Claim Objections

Claim 1 recites "*the address of a further location request handling device*". The examiner notes that there's no prior reference to the above italicized underlined limitation.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim **1, 3-6, 8, and 10-11** rejected under 35 U.S.C. 102(b) as being anticipated by **Havanis** (US Patent No. 6104932)

1. (Currently Amended) A method for handling a location data request or location request relating to a subscriber in a mobile radio network, comprising:

receiving a request from a first location request handling device at a subscriber database of a mobile radio network, for switching device address data of a switching device, via which the subscriber can currently be reached (C4 L20-533); and

determining whether the request is from a version of a location request handling device for which there is provision for the location request handling device to receive switching device address data from the subscriber database as a response (if serving device is serving MLC, MLC's address is looked up C4 L53-58);,

wherein in the event that the request is from such a version of a location request handling device, specifying, via the subscriber database, to the first location request handling device, in a response, location request handling device address data representing the address of a further location request handling device instead of the switching device address data (C4 L20-43; if the GMLC is the serving device then HLR sends MSC address is sent to GMLC)

2. Regarding claim **3, Havanis** teaches the method according to claim 1, wherein the further location request handling device stores profile data of the subscriber, which specifies whether and under what conditions the location request relating to the subscriber should be processed and/or responded to (serving MLC checks user subscription C4 L44-52).

3. Regarding claim **4**, **Havinis** teaches the method according to claim 1, wherein the first older version location request handling device sends the request to the subscriber database after it receives a request from an LCS client (C4 L52-65).

4. Regarding claim **5**, **Havinis** teaches the method according to claim 1, wherein the first location request handling device sends the location request to the address of the further location request handling device, which forwards it to the address of a switching device, which was specified thereto by the subscriber database in response to its request to the subscriber database (C4 L52-65).

5. Regarding claim **6**, **Havinis** teaches the method according to claim 4, except wherein the request includes data of the subscriber to be located identifying the subscriber (C4 L13-19).

6. Regarding claim **8**, **Havinis** teaches the method according to claim 1, wherein the version of the location request handling device is identified by the subscriber database from the non-extended format of the request (the serving MLC is look).

7. Regarding claim **10**, **Havinis** teaches the method according to claim 1, wherein the further location request handling device profile data of the subscriber, in respect of whom a location request is to be implemented, is verified and the further location request handling device contacts the switching device specified to it, if the profile data of the subscriber shows that the location request relating to the subscriber should be carried out. (C4 L48- C5 L6).

8. Regarding claim **11**, it has the same corresponding limitations as that of method claim 1. Therefore it is rejected for the same reasons as claim 1.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim(s) **2 and 9** is/are rejected under 35 U.S.C. 103(a) as being unpatentable over **Havanis** (US Patent No. 6501955) in view of **3GPP** (3gpp Ts 23.271 v6.0.0).

11. Regarding claim **2**, **Havanis** teaches the method according to claim 1, except wherein the further location request handling device is a location request handling device in a home network of the subscriber. In an analogous art, 3GPP teaches an LCS arrangement where the signals has to travel from a RGMLC to a home HGMLC (fig. 6.1-2). Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to combine Havanis' teaching with 3GPP to allow a client to communicate with a home GMLC of a subscriber via a RGMLC.

12. Regarding claim **9**, **Havanis** teaches the method according to claim 1, wherein the version of the location request handling device is identified from a database (C4 L53-65). However, Havenis does not specifically teach a Lh interface used. In an analogous art, 3GPP teaches GMLC receiving various types of data from the HLR data via the Lh interface. Therefore, it would have been obvious for one of ordinary skill in

the art at the time of the invention to provide the detailed data via the Lh interface without having to establish another interface.

13. Claim(s) **7** is/are rejected under 35 U.S.C. 103(a) as being unpatentable over **Havanis** (US Patent No. 6501955).

14. Regarding claim **7**, **Havinis** teaches the method according to one claim 1, wherein the location request handling device address data has a same format as switching device address data. However, it is common sense for the GMLC and MSC to have the same address format so that there is no need for address translation to reduce complexity. Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to have the same format for the addresses from different network components to avoid the complexity of address translation.

Response to Arguments

Applicant's arguments with respect to claims 1-11 have been considered but are moot in view of the new ground(s) of rejection.

The examiner notes that applicant stated that the substitute specification has been filed. However, the examiners failed to receive the substitute specification. Thus the specification objection is maintained.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

Art Unit: 2617

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DUNG LAM whose telephone number is (571) 272-6497. The examiner can normally be reached on M - F 9 - 5:30 pm, Every Other Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Harper can be reached on (571) 272-7605. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/VINCENT P. HARPER/

Supervisory Patent Examiner, Art Unit 2617